

JPW

Docket No.: 1349.1312

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kyu-Cheol SHIN

Serial No. 10/706,959

Group Art Unit: 2852

Confirmation No. 7782

Filed: November 14, 2003

Examiner: Ryan M. Gleitz

For: COLOR IMAGE FORMING APPARATUS

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed May 16, 2004, in the above-identified application, setting a one-month shortened period for response set to expire on June 16, 2005, Applicant respectfully submits the following remarks.

I. Provisional Election of Claims Pursuant to 37 C.F.R. § 1.146

Applicant provisionally elects to prosecute Species II in response to the preliminary election requirement set forth in the Office Action. Applicant respectfully submits that at least claims 1-12 and 17-34 read on Species II.

II. Applicant Traverses the Election Requirement

Initially, Applicant submits that the election of species requirement is not well founded. A careful review of the subject application reveals that the various embodiments are so closely related as to not require separate fields of search. Indeed, it is submitted that at least claims 1, 11, and 12 are generic to both species. Accordingly, neither Applicant nor the U.S. Patent and Trademark Office should be put through the trouble and expense entailed in multiple filing and prosecution. In addition, Applicant submits that the public-at-large should not be required to obtain and study several patents in order to have available all of the issued patent claims covering the invention.

Still further, Applicant notes that the Office has not articulated any rationale supporting its contention that the disclosed embodiments of the claimed invention are either independent or distinct. MPEP § 803 sets forth the requisite criteria for properly restricting the claims of an application. MPEP § 803 specifically requires that: (A) the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) that there must be a serious burden on the Examiner if restriction is not required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth how/why there would be a serious burden if restriction is not required.

Lastly, the making of an election species is not mandatory in all instances where it is possible to do so. Rather, the Examiner may use his discretion and choose not to make an election of species where circumstances warrant. It is believed that such is the case in the subject application. Therefore, Applicant requests, under 37 C.F.R. §1.143, that the Examiner reconsider and withdraw the election requirement set forth in the above-noted Office Action.

III. Conclusion

Applicant respectfully submits in view of the close relation between the various embodiments, the absence of a rationale in support of the election requirement, and the absence of a showing of a burden if the election requirement is not imposed, that the subject election of species requirement should be withdrawn.


There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 6-15-05

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